

**REMARKS**

Claims 1-8 remain pending in this application. Claims 1-8 are rejected. Claims 1-8 are amended herein to express the invention in alternative wording, to broaden language as deemed appropriate and to address matters of form unrelated to substantive patentability issues.

Applicants herein traverse and respectfully request reconsideration of the rejection of the claims and objection cited in the above-referenced Office Action.

Claims 1, 3, 5, 6 and 8 are rejected under 35 U.S.C. § 102(e) as being anticipated by Davis et al. (US Pat. Pub. 2006/0086004 A1). Applicants herein respectfully traverse these rejections. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). It is respectfully submitted that the cited reference is deficient with regard to the following.

Claim 1 recites in pertinent part the following:

heating a sole-plate substrate material made of  
thermoplastic resin;

pressing said heated substrate material relative to a foot sole of a human to prepare a sole-plate substrate having a shape corresponding to a sole arch of said foot sole, said pressing the heated substrate material relative to the foot sole including pushing in a portion of said substrate material corresponding to an apex of a lateral arch of said sole arch to allow said substrate to be formed with a convex portion corresponding to the apex of said lateral arch;

It is respectfully submitted that the cited Davis et al. reference is devoid of teaching or suggestion of “pushing in a portion of said substrate material corresponding to an apex of a lateral arch of said sole arch to allow said substrate to be formed with a convex portion corresponding to the apex of said lateral arch.” This “pushing in” of the selected portion is characterizing of the broader recitation of “pressing said heated substrate material relative to a foot sole of a human to prepare a sole-plate substrate having a shape corresponding to a sole arch of said foot sole” which precedes the later recitation. Applicants respectfully submit that the Examiner has failed to provide any support in the cited reference for alleged disclosure relating to a pushing in of the moldable material. Rather, Davis simply

states that “[t]he softened thermoplastic material is then shaped and detailed to the bottom of a user’s foot ... [and] is molded by hand to all the curves and dimensions of the foot.” This is quite different from pushing in to intentionally create “a convex portion corresponding to the apex of said lateral arch.” In this regard, it is applicants’ position that the act of molding is a passive activity which intentionally follows as faithfully as possible external configurations, whereas pushing in of the softened material seeks to actively alter the finished product as varied from a surface shape present without applied force.

In view of the above, it is respectfully submitted that claims 1, 3, 5, 6 and 8 particularly describe and distinctly claim elements not disclosed in the cited reference. Therefore, reconsideration of the rejections of claims 1, 3, 5, 6 and 8 and their allowance are respectfully requested.

Claim 2 is rejected as obvious over Davis et al. in view of Bivans (US 3,444,291 under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

It is respectfully submitted that the proffered combination of references cannot render the rejected claims obvious because the secondary Bivans reference does not provide the teaching noted above with respect to the anticipation rejection

that is absent from the primary Davis et al. reference. Thus, the combination of prior art references fails to teach or suggest all the claim limitations as is properly required for establishing a *prima facie* case of obviousness.

In addition, the subject matter of claim 2 is directed to the use of a spatula which is brought into contact with a portion of a thermoplastic resin substrate corresponding to an apex of a lateral arch of said sole arch to push in the portion. In stark contrast, the secondary Bivans reference teaches the use of a spatula to fill cavities with a filler composition. Applicants respectfully submit that, while the use of a spatula is commonly used for moving about putty, plaster, spackling compound and other fillers when filling cavities, such as in construction and cosmetic repair, the Examiner has failed to provide art that teaches use of a spatula in connection with the pushing in of a pliable thermoplastic resin sheet, which has properties quite different material from a filler composition.

Thus, it is respectfully submitted that the rejected claim is not obvious in view of the cited references for the reasons stated above. Reconsideration of the rejection of the claim 2 and its allowance are respectfully requested.

Claim 4 is rejected as obvious over Davis et al. in view of Brown (US 3,995,002) under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection.

It is respectfully submitted that the proffered combination of references cannot render the rejected claims obvious because the secondary Brown reference does not provide the teaching noted above with respect to the anticipation rejection that is absent from the primary Davis et al. reference. Thus, the combination of prior art references fails to teach or suggest all the claim limitations as is properly required for establishing a *prima facie* case of obviousness.

In addition, the subject matter of claim 4 recites “attaching a depression forming member onto a long plantar ligament region of said sole arch before said step of pressing the heated substrate material relative to the foot sole, and then pressing the heated substrate material relative to the foot sole to allow said substrate to be formed with a depression corresponding to said depression forming member.” Applicants respectfully submit that the Brown reference is devoid of such teaching. The “splints” being referred to by the Examiner (col. 9, lines 6-9) are not equivalent in any manner to the claimed “depression forming member” as they merely constitute moistened plaster impregnated gauze sheets which are applied in multiple (three) layers to produce a resultant cast when hardened, as is commonly performed to immobilize a limb when broken.

Thus, it is respectfully submitted that the rejected claim is not obvious in view of the cited references for the reasons stated above. Reconsideration of the rejection of the claim 4 and its allowance are respectfully requested.

Claim 7 is rejected as obvious over Davis et al. in view of Geer et al. (US 7,059,067) under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection.

It is respectfully submitted that the proffered combination of references cannot render the rejected claims obvious because the secondary Geer et al. reference does not provide the teaching noted above with respect to the anticipation rejection that is absent from the primary Davis et al. reference. Thus, the combination of prior art references fails to teach or suggest all the claim limitations as is properly required for establishing a *prima facie* case of obviousness.

Thus, it is respectfully submitted that the rejected claim is not obvious in view of the cited references for the reasons stated above. Reconsideration of the rejection of the claim 7 and its allowance are respectfully requested.

No fee is believed due. If there is any fee due the USPTO is hereby authorized to charge such fee to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form  
for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,

JORDAN AND HAMBURG LLP

By Frank J. Jordan by :  
Frank J. Jordan  
Reg. No. 20,456  
Attorney for Applicants

and,

By Lawrence Wechsler  
Lawrence Wechsler  
Reg. No. 36,049  
Attorney for Applicants

Jordan and Hamburg LLP  
122 East 42nd Street  
New York, New York 10168  
(212) 986-2340

FJJ/LIW/cj